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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,155	10/20/2000	Sandrine Decoster	05725.0793-00000	7711

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/692,155

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-92,94 and 95 is/are pending in the application.
- 4a) Of the above claim(s) 86-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-85,94 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 12, 2002 has been entered. Claims 1-92, 94, and 95 are pending.

### ***Election/Restrictions***

Applicant's election with traverse of synthetic oils as a single species of conditioner in Paper No. 15 is acknowledged. The traversal is on the ground(s) that no serious burden is shown to examine all claimed species of conditioner. This is not found persuasive. It was indicated in the election requirement that claim 1, drawn in Markush format, encompasses multiple independent and patentably distinct inventions. Serious burden is in fact imposed on the examiner since search for one invention is not required for another. In response to applicants' argument that no serious burden exist for the claimed subject matters were considered previously, examiner asserts that giving actions on the nonelected inventions does not waive elections when inventions are such of a nature which compels election.

Claims 86-92 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-16, 44-51, 60, 65-71, 82-85, 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn, Jr. et al. (US 5,885,948) ("Glenn") in view of Dalle et al. (EP 0874017) ("Dalle").

Glenn teaches skin cleansing composition comprising hydrogenated polyisobutene. See Examples on col. 15. See instant claims 85, 94, and 95. The example formulations employ the anionic surfactants and amphoteric surfactants of instant claims 44-51, 55, 60, and 65-71. Hydrogenated polyisobutene and the synthetic polyalkyenes disclosed on column 9, lines 33-41 and column 10, lines are said to be the most preferred skin-moisturizing agent. See col. 8, lines 44 – 67; col. 11, lines 4 – 21. The reference further teaches that silicone oils such as polysiloxane also can be used. See col. 10, lines 46 – 55; col. 11, lines 15-16.

While the Glenn reference generally teaches a composition comprising a conditioning oil and polysiloxane, the reference fails to teach the specific type of polysiloxane recited in the instant claims.

Dalle et al. teach a method of making silicone in water emulsions comprising at least one silicone compound that reacts with the polysiloxane of formula (I) in claim 1 by chain extension reaction, and at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants. See p. 1, line 34 – p. 4, line 17. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13-14 in the instant

application. See Examples 1-3 on p. 6. The particle size of the silicone copolymer is also in the range of 0.3 – 100  $\mu\text{m}$ , which meets claims 15-16. See p. 5, lines 35-41. Dalle teaches that the emulsions here can be used in cosmetic compositions including facial cleansers or hair shampoo and conditioner. See p. 5, lines 46 – 57. The reference further teaches that the silicone is “lubricious and will improve the properties” of the compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified the composition of Glenn by adding the polysiloxane copolymers of Dalle, as motivated by Dalle, because of the expectation of successfully producing a cleansing/moisturizing dual-functioning composition which provide smoothness and improved properties.

2. Claims 52-59 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn and Dalle as applied to claims 1-16, 44-51, 60, 65-71, 82-85, 94 and 95 above, and further in view of Dubief et al. (U.S. Pat. No. 5690920) (“Dubief”).

Dalle and Glenn, discussed above, fail to teach the surfactants of instant claims 52-59 and 61-64.

Dubief teaches that the surfactants recited in the instant claims 44-69 are well known in the art. See col. 4, line 6 – col. 5, line 45; examples. The Dubief invention is directed to foamable washing compositions for personal use such as shower gel or foam bath, which comprises water-insoluble silicones and washing base surfactants. See col. 4, lines 1 – 21.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the composition of the combined references by substituting the detergents in Glenn with the conventional surfactants as motivated by Dubief, because of the expectation to have produced shower or bath compositions with similar cleansing and moisturizing effects.

3. Claims 1-17, 25, 27, 44-46, 56, 70-74, 81-84, 94, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwao et al. (US 4183917) ("Iwao") in view of Dalle.

Iwao teaches hair conditioner compositions comprising synthetic oils, such as alpha-olefin polymers. See col. 2, lines 23 – 43. See instant claim 1(A), 94, and 95. The reference further teaches adding quaternary ammonium salts such as distearyldimethylammonium chloride. See col. 2, lines 44 – 59; Table 2 and Examples. See also instant claims 17 (IV), 25, and 27. The reference also teaches to use nonionic surfactants such as polyoxyethylene stearylether. See col. 2, line 60 – col. 3, line 13. See instant claims 44-47, 56.

Iwao et al. fail to teach the silicone copolymer recited in the instant claims.

Dalle, discussed above, teaches that the silicone emulsion is useful in formulating hair products such as hair conditioner, for providing conditioning benefits. See p. 5, lines 51-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Iwao by adding the silicone

copolymer emulsion as motivated by Dalle, because of the expectation of successfully producing hair conditioner composition which provide enhanced conditioning benefits to the hair.

4. Claims 18-24, 26, 28-43, 47-51, 60, 65-69, and 75-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwao and Dalle as applied to claims 1-17, 25, 27, 44-46, 56, 70-74, 81-84, 94, and 95 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

While Iwao and Dalle teach quaternary ammonium cationic surfactants, the combined references fail to teach all of the specific surfactants recited in the instant claims.

Restle teaches that the cited quaternary ammonium surfactants are well known in the art. See col. 3, line 4 – col. 6, line 38. The Restle invention is directed to cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids (silicone surfactants) and cationic amphiphilic lipids. See col. 1, lines 36 – 67. Examples 1 and 2 in the reference also teach employing 1.5 % of the disclosed cationic amphiphilic lipids. See instant claims 41-43. See col. 8, lines 21 – 24 and Example 5 for the application of the composition in personal care products and the surfactants used therein. See instant claims 44-51, 60, 65-84. The Restle reference also teaches the use of synthetic oils including synthetic essential oils, polyethers, and silicone oils. See col. 7, lines 1 – 17. The reference further teaches that the advantages of the compositions include an enhanced penetration of active cosmetic ingredients on hair, and glossy appearance without greasy feel and softness. See col. 1, lines 36-49.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the composition of the combined references by substituting the cationic surfactants there with the cationic amphiphilic lipids in Restle et al. because of the expectation to have produced compositions which would provide similar glossy appearance, and softness on the hair. The process of using the topical composition is viewed obvious.

***Conclusion***

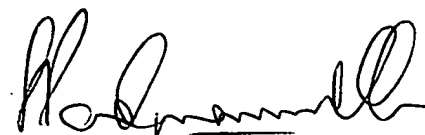
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
February 20, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

2/23/03



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